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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,421

10/18/2006

Maurice Van Eis

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EXAMINER

SHTERENGARTS, SAMANTHA L

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

03/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/586,421	Applicant(s) VAN EIS ET AL.	
	Examiner Samantha L. Shterengarts	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10 and 12-15 is/are pending in the application.
- 4a) Of the above claim(s) 2-4,6,8-10 and 12-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5 and 7 is/are rejected.
- 7) ☒ Claim(s) 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>19 July 2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. The instant application is a national stage entry of PCT/EP05/00502, filed January 19, 2005, which claims foreign priority to British application Nos. 0401090.6, filed January 19, 2004 and 0401089.8, filed January 19, 2004.
2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on July 19, 2006 was in compliance with the provisions of 37 CFR 1.97 and 37 CFR 1.98. The IDS document was considered. A signed copy of form 1449 is enclosed herewith.

Election/Restrictions

4. Applicant's election with traverse of Group I, Claims 2-10 and 12-13 in the reply filed on January 15, 2009 is acknowledged. The traversal is on the ground(s) that the present application does not lack unity because the special technical feature is the compounds being more selectively inhibitory of a particular PKC isoform. Applicant's representative asserts that the common feature is the compounds being more selectively inhibitory and methods of using compounds that are more selectively inhibitory. This is not found persuasive for the following reasons.

An international application should relate to only one invention or, if there is more than one invention, the inclusion of those inventions in one international application is only permitted if all inventions are so linked as to form a single general inventive concept (PCT Rule 13.1).

With respect to a group of inventions claimed in an international application, unity of invention

Art Unit: 1626

exists only when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features.

The claims herein lack unity of invention under PCT rule 13.1 and 13.2 since, under 37 CFR 1.475(a)

Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression “special technical features” shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Groups I-II lack unity of invention since under 37 CFR 1.475: the technical feature corresponding to the claims is the non-variable core that is common to all compounds of formula (I) and methods of using compounds of formula (I). This core technical feature is not a special technical feature because it fails to define a contribution over the prior art as can be seen in US 2002/38561, which discloses the same core as in instant Claim 5.

Therefore, claims 2-10 and 12-15 are not so linked as to form a single general inventive concept and there is a lack of unity of invention because they lack a special technical feature as the technical feature present fails to define a contribution over the prior art. The core technical feature that is being claimed is taught by the prior art. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Furthermore, in regards to Groups I-II, even if unity of invention under 37 CFR 1.475(a) is not considered lacking, which it is as evidenced above, unity is lacking under 37 CFR

Art Unit: 1626

1.475(b). Under 37 CFR 1.475(b): A national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of said product, and a use of said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of said product, and an apparatus or means specifically designed for carrying out the said process.

And according to 37 CFR 1.475(c): if an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph 37 CFR 1.475(b), unity of invention might not be present.

Therefore, since the claims are drawn to compounds and compositions, which do not make a contribution over the prior art, a method of preparing compounds of formula (I), as well as *various* methods of using the compounds of formula I, as in claims 14 and 15 and according to 37 CFR 1.475(e): the determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claims.

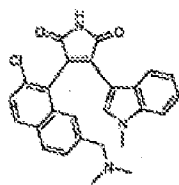
Therefore, since the claims do not relate to a single general inventive concept under PCT Rule 13.1 and lack the same or corresponding special technical feature, the claims lack unity of

Art Unit: 1626

invention.

The requirement is still deemed proper and is therefore made FINAL.

5. As per MPEP 803.02, the Examiner will determine whether the entire scope of the claims is patentable. Applicants' elected species of the following compound has been found not allowable.



As an elected species has been found not allowable, the Markush-type claims have been rejected and claims to the nonelected invention held withdrawn from further consideration.

It has been determined that the entire scope claimed is not patentable.

Status of the Claims

6. Currently, Claims 2-10 and 12-15 are pending in the instant application. Claims 2-4, 6, 8-10, and 12-15 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention. Claims 5 and 7, read on an elected invention and species and are therefore under consideration in the instant application.

Claim Objections

7. Claim 7 is objected to because the last and second to last members of a series should be separated by the word "and" or the word "or," depending on their form. Please see 2173.05(h). Appropriate correction is required.

Art Unit: 1626

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 5 and 7 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of copending Application No. 10/586,420. Although the conflicting claims are not identical, they are not patentably distinct from each other because they teach positional isomers of the instantly elected species.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Determination of the scope and contents of the prior art

Claims 1 and 3 of copending Application no. 10/586,420 are drawn to a positional isomer of the instantly elected species of claims 5 and 7 of the instant application.

Ascertaining the differences between the instant claims and the prior art

Art Unit: 1626

Claims 1 and 3 of copending Application no. 10/586,420 teach the compound 3-(2-chloro-6-dimethylaminomethyl-naphthalen-1-yl)-4-(1-methyl-1H-indol-3-yl)-pyrrole-2,5-dione, which is a positional isomer of the instantly claimed compounds, which teaches the dimethylaminomethyl substituent at position 7, rather than position 6.

Resolving the level of ordinary skill in the pertinent art – Prima facie case of obviousness

With regards to positional isomers, MPEP 2144.09.II. states, “Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. In re Wilder, 563 F.2d 457, 195USPQ 426 (CCPA 1977).

In positional isomerism, a functional group changes position on the chain or ring. As stated in *In re Norris* 179 F.2d 970, 84 U.S.P.Q. 458 (C.C.P.A. 1970), a novel useful compound that is isomeric with the prior art compound is unpatentable unless it possesses some unobvious or unexpected beneficial property not possessed by the prior art compound. In other words, if the positional isomers of the instant application produced unexpected results that would not be obvious to one of ordinary skill in the art, they would be patentably distinct; however, there is no evidence of such results in the instant application.

One of ordinary skill would be motivated, from the disclosure in the prior art, to make the modifications required to arrive at the instant invention with reasonable expectation of success for obtaining a compound with the same utility. The motivation to make the change would be to make additional compound for the quoted purpose.

Art Unit: 1626

Thus, the instant claims are *prima facie* obvious.

Conclusion

9. No claims are allowed.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samantha Shterengarts whose telephone number is (571)270-5316. The examiner can normally be reached on Monday thru Thursday 9-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Samantha L. Shterengarts/
Examiner, Art Unit 1626

/Kamal A Saeed/
Primary Examiner, Art Unit 1626